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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/775,115	02/01/2001	Johnny B. Corvin	UV-179	8786

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EXAMINER	
SHANNON, MICHAEL R	
ART UNIT	**PAPER NUMBER**
2614	

DATE MAILED: 05/03/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary	Application No.	Applicant(s)	
	09/775,115	CORVIN, JOHNNY B.	
	Examiner	Art Unit	
	Michael R Shannon	2614	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

1)☒ Responsive to communication(s) filed on *04 February 2005*.

2a)☐ This action is **FINAL**. 2b)☒ This action is non-final.

3)☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

4)☒ Claim(s) *14-16 and 40-68* is/are pending in the application.

4a) Of the above claim(s) _____ is/are withdrawn from consideration.

5)☐ Claim(s) _____ is/are allowed.

6)☒ Claim(s) *14-16 and 40-68* is/are rejected.

7)☐ Claim(s) _____ is/are objected to.

8)☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

9)☐ The specification is objected to by the Examiner.

10)☒ The drawing(s) filed on *01 February 2001* is/are: a)☒ accepted or b)☐ objected to by the Examiner.

Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).

Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).

11)☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

12)☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).

a)☐ All b)☐ Some * c)☐ None of:

1.☐ Certified copies of the priority documents have been received.

2.☐ Certified copies of the priority documents have been received in Application No. _____.

3.☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

1) ☒ Notice of References Cited (PTO-892)
2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
3) ☐ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08) Paper No(s)/Mail Date _____.
4) ☐ Interview Summary (PTO-413) Paper No(s)/Mail Date. _____ .
5) ☐ Notice of Informal Patent Application (PTO-152)
6) ☐ Other: _____.

DETAILED ACTION

Response to Arguments

1. Applicant's arguments, see pages 12-17, filed 4 February 2005, with respect to the rejection(s)of claim(s) 14, 40, 43, and 46 under 102(b) as being anticipated by Hite (USP 5,774,170) have been fully considered and are persuasive. Therefore, the rejection has been withdrawn. However, upon further consideration, a new ground(s) of rejection is made based on Zigmond (USP 6,698,020), in view of Hendricks (USP 5,734,853). The amendments to claims 14, 40, 43, and 46 have further limited the claims and have given a more clear idea of the inventive concept proposed. Namely, the concept of "in response to the television viewer turning off and on user equipment on which the forces advertisement was being presented, presenting the forced advertisement from the beginning of the forced advertisement or recommencing the forced advertisement from the point at which the user equipment was turned off" has been incorporated into the claim in order to establish that the user is FORCED to watch and cannot avoid viewing the commercial and that the commercial must be viewed in its entirety.

2. Applicant's arguments, see pages 12-17, filed 4 February 2005, with respect to the rejection(s)of claim(s) 49, 54, 59, and 64 under 102(b) as being anticipated by Hite (USP 5,774,170) have been fully considered and are persuasive. Therefore, the rejection has been withdrawn. However, upon further consideration, a new ground(s) of rejection is made based on Zigmond (USP 6,698,020). The Hite reference did disclose a method of pre-empting commercials with commercials that are more targeted for the

individual. The fact that Hite taught an example of NOT replacing an ad with a competitor's ad is not meant to act as a limitation in the disclosure. The ability to pre-empt advertisements, as taught by Hite meets the first half of the claim language. The fact that the forced advertisement is replacing the ad of the competitor is just another modification to this approach and would have been fairly obvious to one of ordinary skill in the art, hence the use of the counter-example in the Hite reference. While the examiner believes the Hite reference to be of sufficient weight in the initial rejection concerning the "competitor" limitation, a further rejection based on the new prior art of record, Zigmond, is discussed below.

Claim Rejections - 35 USC § 103

3. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

> (a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negatived by the manner in which the invention was made.

4. Claims 14-16, and 40-48 are rejected under 35 U.S.C. 103(a) as being unpatentable over Zigmond et al (USP 6,698,020), cited by examiner, in view of Hendricks (USP 5,734,853), cited previously by examiner.

Regarding claims 14, 40, 43, and 46, the Zigmond reference teaches all of that which is discussed with regards to the "method of presenting a forced advertisement to a television viewer" as follows:

- The claimed step of "detecting the forced advertisement in an incoming video stream" is met by the delivery of the program stream and the

targeted advertisements and the subsequent detection of a triggering event in the program stream to trigger the display of the targeted ad [col. 7, lines 2-32].

- The claimed step of "displaying the forced advertisement" is met by the ability to display the targeted advertisement to the viewer via display device 58 [col. 7, lines 30-32].
- The claimed step of "in response to the television viewer turning off and on user equipment on which the forced advertisement was being presented, presenting the forced advertisement from the beginning of the forced advertisement or recommencing the forced advertisement from the point at which the user equipment was turned off" is met by the discussion of eliminating "aggressive channel surfers" [col. 13, lines 16-39]. Here Zigmond teaches recommencing an advertisement on a channel change (thereby forcing the viewer to view the entire commercial no matter how many times the channel is changed).

While Zigmond does teach the ability to change channels and recommence a commercial until it has been significantly viewed by the subscriber, he does not teach turning off the television and starting the advertisement from the beginning once the television is turned back on.

The Hendricks reference teaches an introductory menu 1000 that must be viewed by the user each time the system is turned on [paragraph 119, Detailed

Description], and explains that this is a good time to force users to watch an advertisement.

It would have been obvious to one of ordinary skill in the art at the time of the invention to use the technique of presenting a commercial from its beginning upon power up (as discussed in Hendricks), in order to eliminate the aggressive channel surfing and to therefore force users to view commercials in their entirety.

Regarding claims 15, 41, 44, and 47, the Zigmond reference further meets the claimed step of "preventing the television viewer from changing channels during playing of the forced advertisement." Column 13, lines 16-39 disclose a way of curbing "aggressive channel surfing" which forces the users to view commercials in their entirety and does not allow the switching of channels to other programs before the commercial is fully viewed.

Regarding claims 16, 42, 45, and 48, the Zigmond reference further meets the claim that the "forced advertisement is stored in the user equipment". Column 8, lines 3-7 discuss the use of a local repository for storing targeted advertisements at the user device.

Claim Rejections - 35 USC § 102

5. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

> A person shall be entitled to a patent unless –
>
> (e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the

applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

6. Claims 49-68 are rejected under 35 U.S.C. 102(e) as being anticipated by Zigmond et al (USP 6,698,020), cited by examiner.

Regarding claim 49, 54, 59, and 64 the claimed "method for displaying a forced advertisement on a display" is met as follows:

- The claimed step of "receiving a broadcast advertisement in a video stream" is met by the content provider broadcasting advertisements that are included in the video programming feed [col. 7, lines 12-16].
- The claimed step of "determining that the broadcast advertisement is associated with a first advertiser" is met by the discussion of the advertiser for one car manufacturer having the ability to preclude that of another car manufacturer [col. 14, lines 15-24].
- The claimed step of "selecting a forced advertisement associated with a second advertiser to replace the broadcast advertisement, wherein the second advertiser is a competitor of the first advertiser" is, again, met by the discussion of the advertiser for one car manufacturer having the ability to preclude that of another car manufacturer (competitors) [col. 14, lines 15-24].
- The claimed step of "displaying the forced advertisement on the display" is met by the ability to display the targeted advertisement to the viewer via display device 58 [col. 7, lines 30-32].

Regarding claim 50, 55, 60, and 65 the claimed step of "storing the forced advertisement in user television equipment" is met by column 8, lines 3-7 wherein a local repository for storing targeted advertisements at the user device is disclosed.

Regarding claim 51, 56, 61, and 66 the claimed step of "determining that the broadcast advertisement is associated with a first advertiser comprises detecting programming tags associated with the broadcast advertisement" is met by the ability to identify an advertisement based on information regarding the television content feed [col. 10, line 64 – col. 11, line 13].

Regarding claim 52, 57, 62, and 67 the claimed step of "detecting close captioning data associated with the broadcast advertisement" is met by the monitoring of the closed captioning signal [col. 11, lines 10-13].

Regarding claim 53, 58, 63, and 68 the claimed step of "displaying the forced advertisement for the duration of the broadcast advertisement" is met by the fact that the advertisement originally carried (broadcast advertisement) on the video programming feed is overwritten with the selected advertisement and upon termination of the advertisement, the video programming feed is again displayed to the viewer [col. 4, lines 38-52].

Conclusion

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Michael R. Shannon whose telephone number is (571)

272-7356. The examiner can normally be reached Monday through Friday 8:00 AM – 5:00PM, with alternate Friday's off.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, John Miller, can be reached at (571) 272-7353.

Any response to this action should be mailed to:

Please address mail to be delivered by the United States Postal Service (USPS) as follows:

Mail Stop _____
Commissioner for Patents
P.O. Box 1450
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Effective January 14, 2005, except correspondence for Maintenance Fee payments, Deposit Account Replenishments (see 1.25(c)(4)), and Licensing and Review (see 37 CFR 5.1(c) and 5.2(c)), please address correspondence to be delivered by other delivery services (Federal Express (Fed Ex), UPS, DHL, Laser, Action, Purolater, etc.) as follows:

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Or faxed to: (703) 872-9306

Hand-delivered responses should be brought to:

Knox Building
501 Dulany Street
Alexandria, VA 22314

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to customer service whose telephone number is **(571) 272-2600**.

Michael R Shannon
Examiner
Art Unit 2614

Michael R Shannon
April 18, 2005

JOHN MILLER
SUPERVISORY PATENT EXAMINER
TECHNOLOGY CENTER 2600